

### **Remarks**

Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks. Claims 6, 13, 15, 16, 21, 22, 24-26, 28, 30-35, 38-41, 43-55, 57-59, 62-66, 68, 69, 71-73, and 75-101 are pending in the application. No claims are currently allowed. Claims 6, 16, 21, 22, 24, 26, 30, 32, 33, 35, 44, 47, 49, 57, 59, 65, 66, 78, 81-87, and 95 have been amended with this amendment.

The Office action dated September 20, 2005 ("Action") rejected claims 6, 13, 15, 16, 25, 26, 28, 30-35, 38-40, 45-51, 58, 62-64, 66, 68, 69, 71-73, 75, 78-81, and 85 as being unpatentable over U.S. Patent No. 6,240,555 to Shoff et al. ("Shoff") in view of U.S. Patent No. 6,002,394 to Schein et al. ("Schein"). The Action rejected claims 21, 22, 24, 41, 43, 44, 52-55, 57, 59, 65, 76, 77, 82-84, and 86-101 as being unpatentable over Shoff and Schein in further view of U.S. Patent No. 5,778,181 to Hidary et al. ("Hidary"). Applicants respectfully disagree.

#### **I. Initialed Form 1449 not yet received.**

On May 26, 2005 (stamped received by the U.S. P.T.O. on May 31, 2005), the Applicants submitted an Information Disclosure Statement listing 12 references. The Applicants have not yet received an initialed form 1449 for this IDS. The Applicants respectfully request that the Examiner provide the initialed form 1449 for this IDS. See MPEP § 609 ("An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner assigned to the application.").

#### **II. Patentability of Claims 6, 13, 15, 16, 25, 26, 28, 30-35, 38-40, 45-51, 58, 61-64, 66, 68, 69, 71-73, 75, 78-81, and 85 under § 103(a).**

The Action rejected claims 6, 13, 15, 16, 25, 26, 28, 30-35, 38-40, 45-51, 58, 62-64, 66, 68, 69, 71-73, 75, 78-81, and 85 under 35 U.S.C. § 103(a) as being unpatentable over Shoff in view of Schein. Applicants respectfully submit the claims in their present form are allowable over the cited art.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. Motivations to combine or modify references must come from the references themselves or be within the body of knowledge in the art. *See* MPEP § 2143.01.

**A. Claims 6, 16, 30, 35, and 78 should be allowable.**

Claim 6 has been amended to recite “the graphical control panel is displayed before displaying of the auxiliary data.” Amended claim 6 reads as follows (emphasis added):

responsive to a signal from a viewer during the displaying the icon,  
displaying a graphical control panel operable by the viewer to cause display of the  
auxiliary data associated with the icon, *wherein the graphical control panel is  
displayed before displaying of the auxiliary data.*

For example, the Application at page 4, lines 18-25 describes the graphical control panel and auxiliary data as follows:

If the user actuates a certain button on a user interface selection device, a panel appears on the screen displaying graphical control objects and a description of the related content. If the user actuates one type of graphical control object, the panel disappears. If the user actuates another type of graphical control object, the logical address link is followed to retrieve the related content, and the related content is displayed. While the related content is being retrieved, the television signal may be displayed in a reduced format and a progress indicator displayed until the related content is displayed.

Additional description of the graphical control panel and auxiliary data can be found, for example, in the Application at page 16, line 20 to page 17, line 30 and Figs. 8 and 9.

Claim 16, as amended, recites:

in response to user selection of said icon, displaying a graphical control panel that presents to the user a plurality of options selectable by the user, the options including a first option selectable by the user to indicate desire to return to the displaying the advertising message, and the options further including a second option selectable by the user to indicate desire to view additional information from the Internet relating to the subject of said advertising message, wherein the graphical control panel is displayed before displaying of the additional information.

Claim, as amended, 30 recites:

responsive to a signal from a viewer during the displaying the icon,  
displaying a graphical panel that includes a descriptor of the auxiliary data,  
wherein the panel includes a first graphical control actuable by the viewer to  
indicate desire to return to the displaying the video, and wherein the panel  
includes a second graphical control actuable by the viewer to indicate desire to  
view the auxiliary data;

...  
if the viewer actuates the second graphical control during the displaying the panel,  
ending the displaying the panel; and  
displaying the auxiliary data.

Claim 35, as amended, recites:

responsive to receipt of a first user input signal during the display of the  
icon, causes display of a graphical control panel operable to cause the display of  
the auxiliary data, wherein the graphical control panel includes one or more  
graphical controls actuable to select the display of the television programming  
or the display of the auxiliary data, wherein the graphical control panel includes  
text describing the auxiliary data, and wherein the graphical control panel is  
displayed before displaying of the auxiliary data.

Claim 78, as amended, recites:

responsive to a signal from a viewer during the displaying the icon,  
displaying a graphical control panel operable by the viewer to cause display of the  
auxiliary data associated with the icon, wherein the control panel includes plural  
graphical controls including a first graphical control for causing display of the  
auxiliary data and a second graphical control for ending the displaying the control  
panel, wherein the graphical control panel is displayed before displaying of the  
auxiliary data.

- 1. Shoff and Schein, taken separately or in combination, fail to teach or suggest the above-cited language of claims 6, 16, 30, 35, and 78, respectively.**

Shoff does not teach or suggest the above-cited language of claims 6, 16, 30, 35, and 78, respectively. The Examiner acknowledges that “Shoff is silent in respect to having an information panel that is responsive to a signal from the user to end the information panel and return to watching the television program.” Action, page 3.

Shoff is even further from teaching or suggesting “the graphical control panel is displayed before displaying of the auxiliary data” (claims 6, 35, and 78), “the graphical control

panel is displayed before displaying of the additional information” (claim 16), and “if the viewer actuates the second graphical control during the displaying the panel, ending the displaying the panel; and displaying the auxiliary data” (claim 30). In particular, Shoff describes that “[a]n icon 204 is displayed at the lower right corner of the screen to inform the viewer that the program 202 is interactive compatible.” Shoff col. 9, lines 42-44. According to Shoff, when the user activates the icon, the supplemental content is displayed (“If the viewer decides to enter into an interactive mode, the viewer employs a remote control handset, mouse, keyboard, or other mechanism to actuate the icon 204. This causes the browser 106 to start the target resource located by the target specification listed in the EPG data structure (step 170 via the “yes” branch from step 164).”). Shoff col. 9, lines 54-59. Shoff illustrates this process in Fig. 8a, which is the full-size video program with the icon 204, and Fig 8b, which displays supplemental content after the icon has been activated (“FIG. 8b illustrates a screen 200 that is part of the interactive mode. Here, the video program is constrained within a program boundary 210 which is less than full-screen size. The program boundary 210 has been reduced in comparison to the full-size presentation of FIG. 8a to make room for the supplemental content.”). Shoff col. 10, lines 59-64. Beginning display of supplemental content right after a user actuates an icon (as in Shoff) leads away from “the graphical control panel is displayed before displaying of the auxiliary data” (claims 6, 35, and 78), “the graphical control panel is displayed before displaying of the additional information” (claim 16), and “if the viewer actuates the second graphical control during the displaying the panel, ending the displaying the panel; and displaying the auxiliary data” (claim 30).

Schein describes an example in which:

One or more icons or other visual indicators are located on the television screen in a convenient location, such as the top, right corner. One of these icons may be an icon that represents the television schedule guide. The viewer can move a cursor or other visual indicator to the television guide icon and click thereon to open up the television guide as discussed in detail below. Another icon may be provided, for example, by a commercial sponsor. Moving into and activating this icon allows the viewer to link with a database provided by the commercial sponsor, or to a portion of the television schedule guide database that allows the viewer to purchase an advertised product, make a monetary contribution, respond to a survey, answer a question, or participating in contests with other viewers, for example.

Schein, col. 20, lines 29-44; *see also* col. 20, lines 45-63. Schein thus describes displaying a television guide when a user clicks on a icon, which involves display of

supplemental content right after the user clicks on the icon. This leads away from “the graphical control panel is displayed before displaying of the auxiliary data” (claims 6, 35, and 78), “the graphical control panel is displayed before displaying of the additional information” (claim 16), and “if the viewer actuates the second graphical control during the displaying the panel, ending the displaying the panel; and displaying the auxiliary data” (claim 30). To the extent Schein also describes directly linking to a database when the user clicks on the icon (see Schein col. 20, lines 36-39), this altogether leads away from display of the graphical control panel of claims 6, 16, 30, 35, and 78, respectively.

In addition, Applicants cannot find anywhere within Shoff or Schein a teaching or suggestion to modify the cited prior art references so as to result in the elements of the above-cited language of claims 6, 16, 30, 35, and 78, respectively.

For at least these reasons, Shoff, separately or in combination with Schein, does not teach or suggest all limitations of claims 6, 16, 30, 35, and 78, respectively. Therefore, claims 6, 16, 30, 35, and 78 should be allowable.

**2. The combination of references used to reject claims 6, 16, 30, 35, and 78 is improper.**

In rejecting claims 6, 16, 30, 35, and 78, the Examiner modifies a technique described in Shoff to include “having an information panel that is responsive to a signal from the user to end the information panel and return to watching the television program.” Action page 3. Because the Examiner’s combination changes a principle of operation of Shoff, the Examiner’s modification is improper. *See* MPEP § 2143.01, “THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE.”

According to Shoff, if supplemental content is available and an icon has been activated by the viewer, the supplemental content is displayed right after the icon is activated. Shoff col. 9, lines 20-59. In contrast, the Examiner’s combination of Shoff and Schein involves changing Shoff to include an information panel allowing the user to end the information panel and return to watching the television program. This changes the principle of operation of Shoff in that the supplemental content, which is already available for display in Shoff, is no longer displayed immediately after the icon is activated. Shoff’s automatic activation of supplemental content,

with no icon whatsoever (see Shoff col. 9, lines 60-65) also leads away from the Examiner's modification.

**B. Claims 13, 15, 25, 26, 28, 31-34, 38-41, 43, 44-51, 62-66, 68, 69, 71-73, 75-77, and 79-81 should be allowable.**

Claims 13, 15, 25, 26, 28, 31-34, 40, 41, 43, and 44 ultimately depend on claim 6. Thus, for at least the reasons set forth above with regard to claim 6, claims 13, 15, 25, 26, 28, 31-34, 40, 41, 43, and 44 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 13, 15, 25, 26, 28, 31-34, 40, 41, 43, and 44.

Claims 45-51 ultimately depend on claim 16. Thus, for at least the reasons set forth above with regard to claim 16, claims 45-51 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 45-51.

Claims 62-66 ultimately depend on claim 30. Thus, for at least the reasons set forth above with regard to claim 30, claims 62-66 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 62-66.

Claims 38, 39, 68, 69, 71-73, and 75-77 ultimately depend on claim 35. Thus, for at least the reasons set forth above with regard to claim 35, claims 38, 39, 68, 69, 71-73, and 75-77 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 38, 39, 68, 69, 71-73, and 75-77.

Claims 79-81 ultimately depend on claim 78. Thus, for at least the reasons set forth above with regard to claim 78, claims 79-81 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 79-81.

**C. Claim 85 should be allowable.**

Claim 85 recites, "responsive to said indication of viewer interest, adding data identifying said page of supplementary data to a log." The Examiner does not address the above-cited language in the rejection of claim 85.

The Applicants note, however, that Shoff does not teach or suggest a log or "adding data identifying a page of supplementary data to a log." Schein describes a customized "television schedule guide" which allows users to designate television programs as favorites. Schein col. 15, line 58 to col. 16, line 5. Schein also describes a "favorite channel list" which allows users to

create a favorite list of television channels. Schein col. 10, lines 30-39. Saving television *programs* and *channels* to a favorites list (as in Schein) does not teach or suggest “adding data identifying a *page of supplementary data* to a log,” as recited in claim 85.

In addition, Applicants cannot find anywhere within Shoff or Schein a teaching or suggestion to modify the cited prior art references so as to result in the elements of the above-cited language of claim 85. For at least these reasons, Shoff, separately or in combination with Schein, does not teach or suggest all limitations of claim 85, and claim 85 should be allowable.

Furthermore, as noted above, the combination of Shoff and Schein is improper. For at least this additional reason, claim 85 should be allowable.

**IV. Patentability of Claims 21, 22, 24, 41, 43, 44, 52-55, 57, 59, 65, 76, 77, 82-84, and 86-101 under § 103(a).**

The Action rejected claims 21, 22, 24, 41, 43, 44, 52-55, 57, 59, 65, 76, 77, 82-84, and 86-101 under 35 U.S.C. § 103(a) as being unpatentable over Shoff and Schein in further view of Hidary. Applicants respectfully submit the claims in their present form are allowable over the cited art.

**A. Claims 21, 83, and 95 should be allowable.**

Claim 21 has been amended to recite “responsive to a second further indication of viewer interest, adding identifying data for said page of supplementary data into a favorites folder.”

Claim 83, as amended, recites, “responsive to a second signal from the viewer indicating further interest in the auxiliary data, adding identifying data for the auxiliary data into a favorites folder.”

Claim 95, as amended, recites, “responsive to receipt of a user input signal indicating interest in the auxiliary data, causes addition of identifying data for the auxiliary data into a favorites folder.”

**1. Shoff, Schein, and Hidary, taken separately or in combination, fail to teach or suggest the above-cited language of claims 21, 83, and 95, respectively.**

The Examiner argues that “Schein teaches wherein the television guide display panel provides the user with several options to choose from. One of the options includes adding the selected programs to a favorites list.” Action page 7. Applicants disagree with this characterization of Schein relative to the claims of the present application. Applicants acknowledge that Schein describes a customized “television schedule guide” which allows users to designate television programs as favorites. Schein col. 15, line 58 to col. 16, line 5. Schein also describes a “favorite channel list” which allows users to create a favorite list of television channels. Schein col. 10, lines 30-39. A user manually saving television programs and channels to a favorites list (as in Schein) does not teach or suggest the timing “responsive to a second further indication of viewer interest, adding identifying data for said page of supplementary data into a favorites folder” (claim 21), “responsive to a second signal from the viewer indicating further interest in the auxiliary data, adding identifying data for the auxiliary data into a favorites folder” (claim 83), or “responsive to receipt of a user input signal indicating interest in the auxiliary data, causes addition of identifying data for the auxiliary data into a favorites folder” (claim 95).

The Examiner also argues that “Hidary teaches comprising logs of previously received URLs and in response to the user selection, retrieving and displaying the additional information from the URLs list.” Action page 7. Applicants disagree with this characterization of Hidary relative to the claims of the present application. Applicants acknowledge that Hidary describes: “This control panel provides a list of the URLs that have been broadcast and correspondingly received by the computer 16. This control panel is updated to add a URL code each time a new URL code is received by the PC 16.” Hidary col. 5, lines 48-51. Storing a URL each time a new URL is received (as in Hidary) does not teach or suggest, and in fact leads away from, the timing of “responsive to a second further indication of viewer interest, adding identifying data for said page of supplementary data into a favorites folder” (claim 21), “responsive to a second signal from the viewer indicating further interest in the auxiliary data, adding identifying data for the auxiliary data into a favorites folder” (claim 83), or “responsive to receipt of a user input signal



indicating interest in the auxiliary data, causes addition of identifying data for the auxiliary data into a favorites folder” (claim 95).

In addition, Applicants cannot find anywhere within Shoff, Schein, or Hidary a teaching or suggestion to modify the cited prior art references so as to result in the above-cited language of claims 21, 83, and 95, respectively.

For these reasons, Shoff, Schein, and Hidary, separately or in combination, do not teach or suggest all limitations of claims 21, 83, and 95, respectively. Therefore, claims 21, 83, and 95 should be allowable.

**2. The combination of references used to reject claims 21, 83, and 95 is improper.**

In rejecting claims 21, 83, and 95, the Examiner combines Shoff, Schein, and Hidary. As noted above, the combination of Shoff and Schein is improper. For at least this reason, the combination of Shoff, Schein, and Hidary is also improper.

In addition, the Applicants note that Schein describes a user manually designating selected programs and channels as favorites (*see* Schein col. 10, lines 30-39, col. 15, line 58 to col. 16, line 5), whereas the URL adding feature of Hidary operates automatically and for each new URL (*see* Hidary col. 5, lines 46-59). Hidary thus leads away from the modification the Examiner has made to Schein. In addition, modifying Schein to include the URL adding feature of Hidary (as the Examiner has done) changes the principle of operation of Schein.

Claims 21, 83, and 95 should be allowable.

**B. Claims 22, 24, 52-55, 57-59, and 96-101 should be allowable.**

Claims 22, 24, 52-55, and 57-59 ultimately depend on claim 21. Thus, for at least the reasons set forth above with regard to claim 21, claims 22, 24, 52-55, and 57-59 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 22, 24, 52-55, and 57-59.

Claims 96-101 ultimately depend on claim 95. Thus, for at least the reasons set forth above with regard to claim 95, claims 96-101 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 96-101.

**C. Claims 82, 84, 86, and 87 should be allowable.**

Claim 82 recites, “in response to subsequent link data, skipping displaying the icon based at least in part upon result of comparing the subsequent link data to at least some previous link data.”

Claim 84, as amended, recites:

in response to subsequent link data conveyed with the video, comparing the subsequent link data to at least some of the previously conveyed link data;  
if the subsequent link data matches any of the at least some previously conveyed link data, skipping displaying the icon.

Claim 86 recites:

(g) in response to subsequent logical address link data, comparing the subsequent logical address link data to at least some previous logical address link data;

(h) if the subsequent logical address link data matches any of the at least some previous logical address link data, skipping alerting the viewer.

Claim 87, as amended, recites:

responsive to receipt of subsequent logical address link data, causes comparison of the subsequent logical address link data to at least some previous logical address link data;

...

if the subsequent logical address link data does match any of the at least some previous logical address link data, skips display of the icon during the display of the television programming.

- 1. Shoff, Schein, and Hidary, taken separately or in combination, fail to teach or suggest the above-cited language of claims 82, 84, 86, and 87, respectively.**

The Examiner states that “Shoff-Schein does not expressly teach that in response to subsequent link data, skipping displaying the icon at least in part upon result of comparing the subsequent link data to at least some previous link data.” The Examiner argues, however, that “Hidary specifically teaches comparing at least some previously received URLS (link data) to currently received URLs (link data) ... skipping this previously received URL.” Action page 7. Applicants disagree with this characterization of Hidary relative to the claims of the present application.

Hidary describes detecting “identical URLs sent directly after one another which causes the browser not to fetch URLs in these particular cases.” Hidary col. 5, lines 16-19. According to Hidary, if the URL has not been previously detected, “the specific URL is added to the URL list” and “the browser will access the Web site address indicated by the URL and retrieve the cited Web page(s) 58 via the Internet.” Hidary col. 5, lines 29-33 and Fig. 3. This part of Hidary relates to avoiding Web page access operations when Web page content has already been retrieved. It does not teach or suggest “in response to subsequent link data, skipping displaying the icon” (claim 82), “if the subsequent link data matches any of the at least some previously conveyed link data, skipping displaying the icon” (claim 84), “if the subsequent logical address link data matches any of the at least some previous logical address link data, skipping alerting the viewer” (claim 86), or “if the subsequent logical address link data does match any of the at least some previous logical address link data, skips display of the icon during the display of the television programming” (claim 87).

Elsewhere, Hidary indicates:

Another section on the screen is also preferably used to represent an operational control panel. This control panel provides a list of the URLs that have been broadcast and correspondingly received by the computer 16. This control panel is updated to add a URL code each time a new URL code is received by the PC 16. This list gives the subscriber the flexibility to go back and retrieve particularly informative or interesting Web pages that have already been displayed earlier in the program, or alternatively, to print them out for future reference. Furthermore, the list could include URLs referring to Web pages not displayed with the broadcast program, but that provide further information on a certain topic of interest to the viewer.

Hidary col. 5, lines 46-59. Dedicating a section of a screen to *a control panel that lists URLs* (as in Hidary) is different than, and leads away from, display of an *icon* as recited in claims 82, 84, and 87, respectively. Moreover, *continuing* to list URLs in such a control panel if multiple copies of the URL are received (as in Hidary) further leads away from the “*skip*” icon display language of claims 82, 84, and 87, respectively, and also leads away from the “*skip*” alerting a viewer language recited in claim 86.

In addition, Applicants cannot find anywhere within Shoff, Schein, or Hidary a teaching or suggestion to modify the cited prior art references so as to result in the above-cited language of claims 82, 84, 86, and 87, respectively.

For these reasons, Shoff, Schein, and Hidary, taken separately or in combination, do not teach or suggest all limitations of claims 82, 84, 86, and 87, respectively. Therefore, claims 82, 84, 86, and 87 should be allowable.

**2. The combination of references used to reject claims 82, 84, 86, and 87 is improper.**

In rejecting claims 82, 84, 86, and 87, the Examiner combines Shoff, Schein, and Hidary. As noted above, the combination of Shoff and Schein is improper. For at least this reason, the combination of Shoff, Schein, and Hidary is also improper.

In addition, the Applicants note that dedicating a section of a screen to a *control panel that lists URLs* (as in Hidary) leads away from the modification the Examiner has made relating to display of an *icon* in Shoff/Schein. Moreover, *continuing* to list URLs in a control panel if multiple copies of the URL are received (as in Hidary) leads away from the modification the Examiner has made relating to *skipping* icon display and alerts to a viewer.

Claims 82, 84, 86, and 87 should be allowable.

**D. Claims 88-94 should be allowable.**

Claims 88-94 ultimately depend on claim 87. Thus, for at least the reasons set forth above with regard to claim 87, claims 88-94 should be in condition for allowance. Applicants will not belabor the merits of the separate patentability of claims 88-94.

**V. Editorial Claim Language Changes**

Applicants have also made various editorial changes to claim language. Specifically, claims 6, 30, 78, and 82-84 recite “video” language in place of “television signal” language, claim 16 recites “advertising message” language in place of “televised” advertising message language, and claims 21, 85, and 86 recite “video” language in place of “television programming” language. In addition, dependent claims of the above independent claims have been amended to correspond to their respective independent claims.


**Conclusion**

The claims in their present form should now be allowable. Such action is respectfully requested.

Respectfully submitted,

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